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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,282	10/22/2003	Larry Lee Lough	1749.003US2	4902

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EXAMINER	
KASTLER, SCOTT R	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED. 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/691,282	LOUGH, LARRY LEE	
	Examiner	Art Unit	
	Scott Kastler	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *8-12 and 14* is/are allowed.

6)☒ Claim(s) *1,2,6,7 and 15-19* is/are rejected.

7)☒ Claim(s) *3-5 and 13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10-22-2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Objections

Claims 6, 7, 17 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The above claims do not properly further limit independent apparatus claims 1 and 15 from which they depend, because the above claims recite only limitations dealing with the manner or method of use of the claimed apparatus, and it has been well settled that the manner or method of use of an apparatus cannot be relied upon to fairly further limit claims to the apparatus itself. see *In re Casey*, 152 USPQ 235 and MPEP 2114.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 6, 7 and 15-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/691158. Although the conflicting claims are not identical, they are not patentably distinct from each other because the screen member of the '158 application, which

screens material so that they have a diameter of below 2 millimeters includes screens within the scope of the screen of the above claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 6, 7, 15-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohland et al in view of either of Hillis or Todd et al. Bohland et al teaches an apparatus for crushing glass waste and separating heavy metals therefrom including a grinding device (the crusher (50)) for forming crushed particles, a screen (61) for filtering the particles to any desired diameter (including below 2mm in diameter) and transporting larger than desired particles back to the crushing device, a conveyor (80) for transporting the glass particles to a tank (96) containing an etchant of water and acid (see table 1 for example) where the etchant solution and particles are circulated and may include extra circulation means (see col. 6 lines 49-55 for example), and a screen and conveyor device (112) for removing the treated particles from the tank, thereby showing all aspects of the above claims except the use of either a circulating pump for additionally circulating the solution (etchant) or a pumping device for emptying the tank and

filling the tank with either water or etchant, although the tank (96) of Bohland et al would have to be filled and emptied in some, unspecified manner. Both of Hillis (see col 3 lines 25-35 for example) and Todd et al (see the embodiment of figure 3 for example) teach that in the etchant delivery art it was known at the time the invention was made to both employ circulation pumps to additionally circulate an etching solution in a bath in order to provide a more effective and quicker reaction time, and to employ pumps for the effective delivery and withdrawal of fluids from a processing tank. Because Bohland et al would also desire improved reaction times (and specifically allows for devices which increase circulation of the etchant) and would also require some type of delivery and withdrawal system for the fluids employed in the tank (96), motivation to employ the pumps taught by either of Todd et al or Hillis to be well known expedients in the art for these purposes, in the system described by Bohland et al, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

Duplicate Claims

Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In the instant case, claim 13 differs from claim 12 only in the specific manner in which the regulating device is to be employed, and as stated above, the manner or method of use of an apparatus cannot be relied upon to fairly further limit claims to the apparatus itself.

Allowable Subject Matter

Claims 8-12 and 14 are allowed at least because none of the cited or applied prior art shows or fairly suggests the inclusion of a regulating device which monitors the temperature of the bath and adjusts either or both of the temperature or the operation of the circulation pump in response to the monitored temperature.

Claims 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims at least for the reasons given with respect to claim 8 above.

The following is a statement of reasons for the indication of allowable subject matter: Instant claim 19 contains subject matter which if written in independent form including all limitations of the claims from which they depend and upon obviation of the above "obvious type" double patenting rejection, would be allowable over the instantly applied and cited prior art at least because none of the instantly cited or applied prior art shows or fairly suggests an additional rinsing tank as described in the above claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

Scott Kastler
Primary Examiner
Art Unit 1742

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